

each n is independently 0 to 3, and the pharmaceutically acceptable, salts, esters, amides, and prodrugs thereof. *A*

REMARKS

Reconsideration of the Office Action mailed October 25, 1999 (hereinafter "instant Office Action"), entry of the amendments hereinabove, withdrawal of the rejection of claims 1, 2, 4-7, 10, 11, 16 and 18, and withdrawal of the objection to claims 3, 8, 12-15, 17, 19-31, 33, 35-37, 42 and 43, are respectfully requested.

In the instant Office Action, claims 1-43 are listed as pending; claims 1, 2, 4-7, 10, 11, 16 and 18 are listed as rejected and claims 3, 8, 12-15, 17, 19-31, 33, 35-37, 42 and 43 are listed as being objected to. After entry of the amendments hereinabove, the pending claims are 1-8, 10-30, 32, 34, 38-41 and 44-50.

The Examiner has issued a restriction requirement under 35 U.S.C. §121 and §372 alleging that there are two groups of inventions: Group I, claims 1-8, in part and 10-43, in part drawn to non-heterocyclic compounds, compositions and methods of use; and Group II, claims 9, 1-8, in part, and 10-43, in part, drawn to heterocyclic compounds, compositions, and methods of use. During a telephone interview with Mr. Charles Ashbrook on October 5, 1999, a provisional election was made with traverse to prosecute the invention of Group I. Mr. Ashbrook also elected a single species, 3-[3-methyl-2-(phenethylcarbamoyl-methyl)-butyrylamino]-5-(naphthalen-1-yl-acetoxy)-4-oxo-pentanoic acid, for search purposes only. Applicants affirm the election of Group I for prosecution.

The Examiner has rejected claim 1 under 35 U.S.C. §102(b) as allegedly being anticipated by Dolle et al., Mjalli et al., Heng et al., Chapman et al., and Prasard et al. for the reasons stated at pages 4 and 5 of the instant Office Action. Applicants have amended claim 1 so that claim 1 no longer claims compounds that are disclosed by Prasard et al. (see the first two structures of the proviso section), Mjalli et al. (see the third structure at the beginning of the

proviso section), Dolle et al. (see proviso clause (a)), Heng et al. (see proviso clause (c)) and Chapman et al. (see proviso clause (d)). Further, Applicants have also entered proviso clause (b) to avoid the overlap with Mjalli et al. (1995), which the Examiner has not specifically cited against the claims of the instant application. Accordingly, the rejection of claim 1 under 35 U.S.C. §102(b) is obviated and should be withdrawn.

The Examiner has rejected claims 2, 4 and 5 under 35 U.S.C. §102(b) as allegedly being anticipated by the compounds listed in claim 2 of Dolle et al. Applicants respectfully point out that claims 2, 4 and 5 are each dependent upon claim 1 and since amended claim 1 is no longer anticipated by Dolle et al., claims 2, 4 and 5 are no longer anticipated by Dolle et al. Accordingly, the rejection of claims 2, 4 and 5 under 35 U.S.C. §102(b) over Dolle et al. should be withdrawn.

The Examiner has rejected claims 6, 7 and 10 under 35 U.S.C. §102(b) over Prasad et al. The Examiner has specifically pointed out that examples 17 and 19 of Table 1 of Prasad is encompassed by claims 6, 7 and 10. Since claims 6, 7 and 10 are dependent upon claim 1 and Applicants have amended claim 1 to remove examples 17 and 19 of Table 1 of Prasad, claims 6, 7 and 10 are no longer anticipated by Prasad et al. Accordingly, the rejection of claims 6, 7 and 10 under 35 U.S.C. §102(b) over Prasad et al. should be withdrawn.

The Examiner has rejected claim 11 under 35 U.S.C. §102(b) over Mjalli et al. (1994). Since claim 11 is dependent upon claim 1 and Applicants have amended claim 1 to proviso out compound 4c of Mjalli et al. (1994), claim 11 is no longer anticipated by Mjalli et al. Accordingly, the rejection of claim 11 under 35 U.S.C. §102(b) over Mjalli et al. should be withdrawn.

The Examiner has rejected claim 16 under 35 U.S.C. §102(b) over Heng et al. The Examiner specifically points to example 31 of Heng et al. Since claim 16 is dependent upon claim 1 and Applicants have provisoed out the overlap with Heng et al. from claim 1, claim 16 is no longer anticipated by Heng et al. Accordingly, the rejection of claim 16 under 35 U.S.C. §102(b) over Heng et al. should be withdrawn.

The Examiner has rejected claim 18 under 35 U.S.C. §102(b) over Dolle et al. Since claim 18 is dependent upon claim 1 and Applicants have provisoed out the overlapping subject matter with Dolle et al. from claim 1, claim 18 is no longer anticipated by Dolle et al.

Accordingly, the rejection of claim 18 under 35 U.S.C. §102(b) over Dolle et al. should be withdrawn.

Applicants gratefully acknowledge the allowance of claims 32, 34 and 38-41.

The Examiner has objected to claims 3, 8, 12-15, 17, 19 and 20-30 as being dependent upon a rejected base claim. The Examiner has noted that the claims would be allowable if rewritten in independent form. Applicants would readily change the claims to independent claims to secure an allowance of said claims. However, it is Applicants' belief that amended claim 1, upon which said claims depend, overcomes the rejections levied against it in the instant Office Action. Therefore, Applicants respectfully request that the objection to claims 3, 8, 12-15, 17, 19 and 20-30 be withdrawn.

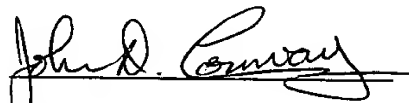
The Examiner has noted that claims 31, 33, 35-37, 42 and 43 would be allowable if the non-elected heterocyclic compounds are withdrawn from said claims. Applicants have cancelled claims 31, 33, 35-37, 42 and 43 and have replaced them with new claims 44, 45, 46, 47, 48, 49 and 50, respectively, wherein the new claims do not include compounds having heterocyclic groups. Notwithstanding the foregoing, Applicants have excluded such heterocyclic compounds, without waiver or prejudice to Applicants' right to file a divisional or continuation application directed to said compounds and the deletion of said compounds is not to be construed as an abandonment of the subject matter.

No new fees are due for the amendments to the claims since the number of total claims and the number of independent claims have not changed. **However, if any fee is deemed to be due in connection with the filing of the instant amendment, Applicants hereby authorize the Commissioner to charge said fees to Deposit Account No. 02-1196.**

Based upon the foregoing, Applicants believe that claims 1-8, 10-30, 32, 34, 38-41 and 44-50 are in condition for allowance. Prompt and favorable action is earnestly solicited.

Respectfully submitted,

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